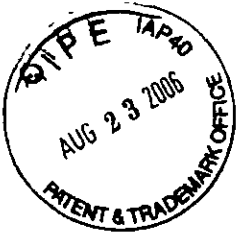


TTAB



PLEASE DATE STAMP AND RETURN AFTER FILING TO TMK  
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

KAPALUA LAND Co. Ltd.

Petitioner,

v.

KAPALUA STRICKWAREN GmbH

Respondent.

74/657998

Cancellation No. 92/040,092

Paper(s) filed:

1. **REPLY MEMORANDUM IN SUPPORT OF PETITIONER'S  
MOTION FOR SUMMARY JUDGMENT**  
*With Enclosures:*  
A. **Exhibit 3**
2. **CERTIFICATE OF SERVICE**

**DOCKET NO.: 500162**  
**ATTORNEY: LAL/kcl**

W. Mack Webner  
Leigh Ann Lindquist  
Attorneys for Petitioner  
SUGHRUE MION, PLLC  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037-3202  
Telephone: (202) 663-7409

**Date: August 23, 2006**

08-23-2006

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**Kapalua Land Company, Ltd.** )

**Petitioner** )

**v.** )

**Kapalua Strickwaren GmbH Ltd.** )

**Respondent** )

**Cancellation No. 92/040,092**

**Reply Memorandum In Support  
of Petitioner's Motion  
For Summary Judgment**

---

## **TABLE OF CONTENTS**

I.	INTRODUCTION.....	p. 1
II.	REGISTRATION NUMBER 2,016,976.....	p. 1
III.	REGISTRATION NUMBER 2,115,124.....	p. 1
A.	Respondent's Original Discovery Responses Are of Record.....	p. 1
1.	Respondent Failed to File a Motion to Amend.....	p. 2
2.	Respondent Failed to Timely Search Its Records.....	p. 2
3.	Respondent Did Not Timely Supplement Its Responses.....	p. 3
B.	Petitioner's Discovery Requests Were Clear.....	p. 3
C.	Respondent's Exhibits Do Not Show Use of the Mark on the Goods.....	p. 4
D.	Board Precedent Does Not Support Respondent's Position.....	p. 6
E.	Fraud is the Only Explanation for Respondent's Conduct .....	p. 9
F.	The Registration Cannot Be Renewed.....	p. 9
IV.	CONCLUSION.....	p. 10

## **TABLE OF AUTHORITIES**

### **CASES**

<u>Bison Corp. v. Perfecta Chemie B.V.</u> , 4 USPQ2d 1718 (TTAB 1987).....	p. 3
<u>Maids to Order of Ohio v. Maid-To-Order, Inc.</u> , 78 USPQ2d 1899 (TTAB 2006)....	p. 6, 7
<u>Medinol Ltd. v. Neuro Vasx Inc.</u> , 67 USPQ2d 1205, 1210 (TTAB 2003).....	p. 9
<u>Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha</u> , 77 USPQ2d 1917 (TTAB 2006).....	p. 7, 10

### **RULES**

Trademark Rule § 2.134(a) .....	p. 1
Trademark Rule § 2.134(b) .....	p. 1
TBMP §407.04.....	p. 2
TBMP §408.....	p. 2
TBMP §408.02.....	p. 2
TBMP §408.03.....	p. 3
TMEP §1604.07 (b) .....	p. 9
TMEP §1604.07 (c) .....	p. 9
Fed. R. Civ. P. 26(e).....	p. 3
Fed. R. Civ. P. 26(e)(2).....	p. 3
Fed. R. Civ. P. 26(g)(2).....	p. 2

## **I. INTRODUCTION**

Petitioner seeks cancellation of two registrations: Registration Number 2,016,976 and Registration Number 2,115,124 both for the trademark KAPALUA. Petitioner's Memorandum in Support of its Motion For Summary Judgment ("Petitioner's Memorandum") sets forth material facts as to which there is no genuine issue in dispute. Respondent's Brief in Opposition ("Respondent's Brief or Resp. Br. ") to Petitioner's Motion does not raise any credible disputed genuine issue of material fact in this case as detailed below, and Petitioner's Summary Judgment Motion should be granted.

## **II. REGISTRATION NUMBER 2,016,976**

Respondent concedes that Registration Number 2,016,976 is subject to cancellation. Pursuant to Trademark Rules § 2.134(a) and (b), judgment should be entered in favor of Petitioner and Registration No. 2,016,976 should be cancelled.

## **III. REGISTRATION NUMBER 2,115,124**

### **A. Respondent's Original Discovery Responses Are of Record.**

On three different occasions (in December 2005, February 2006 and May 2006), Respondent stated that it had not used the KAPALUA mark on all of the goods listed in Registration No. 2,115,124. In its responses to interrogatories, responses to request for admissions and Answer to the Amended Petition to Cancel,<sup>1</sup> Respondent had three opportunities to review its files and respond to the basis of the pending motion.

It was not until Petitioner filed its Summary Judgment Motion on June 13, 2006 that Respondent amended its responses to interrogatories (served on October 28, 2005 and answered on December 16, 2005, with a verification dated December 22, 2005) and

---

<sup>1</sup> No motion to amend the Answer to the Amended Petition to Cancel was filed. That pleading remains of record.

its responses to request for admissions (served on January 19, 2006 and answered on February 23, 2006). The amended responses were served on August 8, 2006 with the verification of the interrogatories dated the same day. This is months after discovery closed on April 16, 2006.

**1. Respondent Failed to File A Motion to Amend.**

Under Trademark Trial and Appeal Board ("Board") Rules, "any matter admitted ... is conclusively established unless the Board, on motion, permits withdrawal or amendment of the admission". TBMP § 407.04 (emphasis added). Accordingly, a motion must be filed to amend any response to a request for admission.

Respondent failed to file a motion with the Board to amend its original responses to Petitioner's Request for Admissions; it merely served its amended responses on Petitioner and attached them as an Exhibit to its Brief in Opposition to Petitioner's Motion. The amended admission responses are not properly before the Board and are not of record for purposes of deciding Petitioner's Summary Judgment Motion.

**2. Respondent Failed to Timely Search Its Records.**

Respondent had a duty to cooperate, search records and supplement its answers to all discovery requests. Fed R. Civ. P. 26(g)(2); TBMP § 408. Under TBMP § 408.02, Respondent had a "duty to thoroughly search its records for all information properly sought in the request, and to provide such information to the requesting party within the time allowed for responding to the request." (emphasis added). The Board has interpreted and explained this requirement.

It is unfair for a party to ... fail to make a complete investigation to locate the information. Each party has an obligation to thoroughly check its records ... to provide the requested discovery .... opposer is not justified in having

failed to submit the questioned documents to applicant simply because no thorough investigation was made initially.

Bison Corp. v. Perfecta Chemie B.V., 4 U.S.P.Q. 2d 1718, 1720 (T.T.A.B. 1987).

Respondent waited until a summary judgment motion was filed to allegedly search its records thoroughly. Petitioner served its interrogatories on October 28, 2005 and Requests for Admission on January 19, 2006. Respondent only decided to allegedly search its records “thoroughly” when the evidence showed that it made a fraudulent filing. It is unfair to Petitioner to permit Respondent to amend its answers to any discovery requests at this late stage in the proceedings when the basis for such an amendment is allegedly that a thorough review of the files was only recently conducted.

### **3. Respondent Did Not Timely Supplement Its Responses.**

Under TBMP § 408.03 and Fed. R. Civ. P. 26(e), Respondent had a duty to supplement or correct its answers to interrogatories and requests for admission. Supplement or correction must be made “if the party learns that the response is in some material respect incomplete or incorrect”. Fed R. Civ. P. 26(e)(2). Respondent had months to supplement its answers and was required to do so. It never did. Respondent has blatantly disregarded Board practice and procedure, Board Rules, and the Rules of Federal Civil Procedure. These responses should be given no weight.

### **B. Petitioner’s Discovery Requests Were Clear.**

Respondent attaches the Declaration of Nicolaus Reusch in support of its argument.<sup>2</sup> Mr. Reusch understands English and German. Somehow, however, he was confused by the translation of the goods listed in Registration No. 2,115,124. That

---

<sup>2</sup> Petitioner objects to the attachments to the Reusch Declaration; none of the documents were produced during the discovery period and the amended discovery responses are not properly of record.

registration covers: clothing, namely, dresses, skirts, jackets, suits, pullovers, sweaters, pants, shorts, shirts, T-shirts, socks, underwear, shoes, gloves, and hats.

In its Request for Admissions, Petitioner specifically listed each and every good identified in Registration No. 2,115,124 in separate admission requests. Attached as Exhibit 3 is a copy of Respondent's Response to Petitioner's First Set of Admissions to Respondent. For example, Request No. 3 asked "Admit that Respondent has never sold or offered for sale dresses under the mark KAPALUA in the United States."

It is simply inconceivable that there could be translation problems when the person responding speaks both English and German, and the goods listed in the registration (and separately in the requests) are common everyday items. The request for admissions could not have been any clearer. The separate requests ensured there could be no confusion as to which clothing item was or was not being sold under the mark. And, on three occasions, Respondent consistently answered the same information.

**C. Respondent's Exhibits Do Not Show Use of the Mark on the Goods.**

In the unlikely event the Board considers the attachments to Respondent's Memorandum, those exhibits do not show use of the mark on the goods.

Respondent submits several catalogues it asserts supports its present contention of use of its mark on the goods that it earlier said it did not have use, namely shoes, underwear and socks. The catalogues are little more than picture books and none of the pictures show the use of the mark.

Exhibit 3 is undated and when, if ever, it was published is unknown. Exhibit 4 has a handwritten date on it without explanation as to when the date was placed on the Exhibit. Exhibits 3 and 4 do not even depict real products. They are drawings. There is



no evidence that the items in the catalogue were ever manufactured; that there were any orders for the products depicted; or that any of the products depicted were sold anywhere, including in the United States. Had there been orders and sales in the United States, Respondent would have probably submitted them. Finally, there is no evidence that any of the items bore the trademark KAPALUA. Though the use at issue must be use of the mark in the United States, none of the captions on the drawings in Exhibits 3 and 4 are in English, and the prices of the items are in Euros. Moreover, there are no shoes, socks or underwear depicted in the Exhibits.

Exhibit 5 is a collection of pictures of women, presumably models. The Exhibit does not indicate what the purpose of the Exhibit was or is. The last page of the Exhibit references Articiel-number (sic) and colour (sic), neither American spellings of these words. None of the references on the last page correlate to the pictures of the people shown in the Exhibit. No underwear or socks are depicted. There is no evidence that the clothes the models are wearing bear the mark or that any of these clothes are offered for sale or are sold in the United States (or anywhere else, for that matter). There is no evidence of a sale being made or of an order being taken for any of these clothes.

Exhibit 6 is a brochure also bearing a handwritten date, unknown as to when it was placed on the Exhibit. There is no use of KAPALUA and no evidence of U.S. sales. The prices are in Euros and none of the items displayed are shoes, underwear or socks.<sup>3</sup>

Exhibit 7 is a two-page Accessories brochure. The exhibit shows shoes with no display of the KAPALUA mark. The exhibit is dated 2006, not 2004. The prices are in

---

<sup>3</sup> Slippers, even those with leggings on them, do not qualify as socks, nor do leg warmers. Mr. Reusch understood when he said there was no use on shoes, underwear and socks.

Euros. No invoices or orders are made of record to evidence U.S. sales; the document does not evidence that the goods have been offered for sale in the United States.

It is unclear if Exhibit 8 is a catalogue of models or a catalogue for clothing. There is no indication of what is being sold or offered for sale, if anything. No description of the goods, no prices, no orders, no invoices are provided. There are no socks, underwear or shoes. The last page suggests that if it is a catalogue of clothing, some of the items shown are products of other companies. What is Respondent's clothing and what is not is not indicated.

Finally, Exhibit 9, like the other Exhibits, does not evidence use of the Mark on any clothing, much less on shoes, underwear or socks. Again, some of the items depicted may well be those of the companies listed as "In cooperation with" at the end of the brochure. As with the other exhibits, there is no evidence that the items shown in Exhibit 9 were ever sold in the United States or even offered for sale here.<sup>4</sup>

**D. Board Precedent Does Not Support Respondent's Position.**

Respondent argues that it did not file a fraudulent affidavit at the Trademark Office because it was mistaken and had no intent to commit fraud. Respondent relies on Maids to Order of Ohio v. Maid-To-Order, Inc., 78 U.S.P.Q.2d 1899 (T.T.A.B. 2006).

There, the issue was the registrant's understanding of use in interstate commerce. The Board held that a layperson could reasonably believe, under the facts of that case, that the respondent's services were offered in interstate commerce. The Board said: "we need only decide whether MTO's president, Ms. Kern, at the time of filing the

---

<sup>4</sup> The last pages of Exhibits 8 and 9 state: "Enjoy visiting the KAPALUA GOLF RESORT on Maui/Hawaii" - Petitioner's resort. The unauthorized use of Petitioner's well-known resort to publicize Respondent's products reflects negatively on the credibility of the declarations. If Respondent associates itself with Petitioner without authority to do so, why should anything in its Declarations be believed?

application, the Section 8 declaration, and the application for renewal, knowingly made a false representation with respect to use of the mark in interstate commerce. If she had a reasonable or legitimate basis for the representations, then MTO has not committed fraud.” Maids to Order, 78 U.S.P.Q.2d at 1906.

The facts in Maids To Order are significantly different from the facts in this case. Here, Respondent made admissions of factual matters. On three separate occasions, Respondent merely had to state facts not interpret the law. No legal training was required to determine if the mark had been used in the United States on common clothing items.

The Board decision in Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha, 77 U.S.P.Q.2d 1917 (T.T.A.B. 2006) is directly on point. There, the Board found the Opposer fraudulently obtained three trademark registrations. When Opposer filed its statements of use, the marks were not in use in commerce on some of the clothing goods listed in the applications.

The Board applied a multi-part test to determine the issue of fraud: (1) Were the statements made false; (2) Were the false statements material to the issuance of the registrations; and (3) Did fraud occur. 77 U.S.P.Q.2d at 1926-1927. There, the marks were not used on all the goods at the time the statements of use were signed. The statements of use were false. The false statements were also material to the issuance of the registrations. Id. at 1927. Last, the Board determined that fraud had been committed.

Opposer claimed it made an honest mistake when signing the statements of use. Id. The Board found that, if there was a mistake, it was a not a reasonable one: “The language in the application ... is clear, and its meaning is unambiguous.” Id. Moreover, “opposer’s claim that the mistake was innocent is not credible”. Id. Opposer understood

that a mark had to be in bona fide use in the ordinary course of trade in order to claim use in commerce. Id. The Board found that with respect to two of the registrations, opposer simply disregarded the significance of the statements it signed. Id.

With the third registration, the Board found that the person who signed the statement of use “had no idea which, if any, of the listed items were being sold in the United States.” Id. at 1928. The Board further admonished: “Opposer is charged with knowing what it is signing and by failing to make any appropriate inquiry, [Opposer] signed the statement of use with a ‘reckless disregard for the truth.’” Id. (citing Medinol).

Specific or actual intent “is not material to the question of fraud.” Id. In fact, “proof of specific intent to commit fraud is not required ... fraud occurs when an applicant or registrant makes a false material representation that the applicant or registrant knew or should have known to be false.” Id. (quoting General Car and Truck Leasing Sys., Inc. v. General Rent-A-Car Inc., 17 U.S.P.Q.2d 1398, 1440 (S.D. Fla. 1990)).

Here, based on the record before the Board, Respondent’s statements in its Section 8 affidavit were false; Respondent admitted on three occasions it had no use of the mark on some of the goods in the registration.<sup>5</sup> Respondent’s “mistake” is not a reasonable one; it knew in December 2006, February 2006 and May 2006 that it had no use of the mark on those goods. Respondent had a duty to ensure that there was use of its mark in the United States at the time the Section 8 was filed. It never made such an inquiry; the declaration was signed with “reckless disregard for the truth”. As the Board has noted, specific or actual intent to commit fraud is not required.

---

<sup>5</sup> Respondent’s exhibits do not show use of the KAPALUA mark on the goods and do not support Respondent’s amended discovery responses. Respondent has not used the mark on the shoes, underwear and socks.

**E. Fraud is the Only Explanation For Respondent's Conduct.**

One answer to one interrogatory or a request for admission might be given in error. The probability that answers to two interrogatories, several Admissions and the Answer to the Amended Petition are all mistakenly made is statistically improbable. It is improbable that the declarant understands the English terms for all of the items of clothing and other products in the identification of goods covered by the registrations except those for which it admitted it did not have use. See Medinol Ltd. v. Neuro Vasx Inc., 67 U.S.P.Q.2d 1205, 1210 (T.T.A.B. 2003) ("Neither the identification of goods nor the statement of use itself were lengthy, highly technical, or otherwise confusing").

Petitioner has shown that there are no genuine issues as to any material facts relative to the fraud committed in filing the Section 8 affidavit to maintain Registration No. 2,115,124. The Respondent has been unable to credibly recant its original and clearly honest and forthright answers to discovery and the Amended Petition to Cancel.

The Respondent argues that now that its registration is in jeopardy it regrets its misunderstanding of English and that it should be able to amend its discovery answers. It cites no precedence for this unusual step and ignores Board procedures.

**F. The Registration Can Not Be Renewed.**

Respondent provides the full text of TMEP § 1604.07(b) regarding ownership when filing declarations of continued use. However, Respondent fails to cite the subsequent section of the Trademark Manual of Examining Procedure - § 1604.07(c) - and mistakenly states that "there is no requirement ... to record [transfer] documents." Resp. Br. p. 15. That section, entitled "Acceptance Notice Issued in Name of Owner of Record", provides that: "the USPTO will not issue the notice of acceptance of the §8

affidavit in the name of the new owner unless the new owner (1) records the appropriate document in the Assignment Services Division; and (2) notifies the Post Registration examiner that the document has been recorded.” TMEP §1604.07(c).

The Trademark Office cannot and will not issue a notice of acceptance of the Section 8 affidavit filed in this case. An assignment must be recorded with the Assignment Division of the U.S. Patent and Trademark Office to show ownership in the current owner’s name. Respondent has failed to file such an assignment. The Section 8 affidavit cannot be accepted; the Registration should now be cancelled.

#### IV. CONCLUSION

Respondent has failed to put in dispute any genuine issue of material fact. Accordingly, Petitioner’s Motion should be granted. Registration Number 2,016,976 should be cancelled and judgment entered for Petitioner on the claims set forth in the Petition. Registration Number 2,115,124 should be cancelled for filing a false Section 8 declaration, or in the alternative, cancelled as abandoned for failure of the registered owner to file a Declaration of Use.

Respectfully submitted,



W. Mack Webner  
Leigh Ann Lindquist  
**Sughrue Mion PLLC**  
2100 Pennsylvania Ave. N.W.  
Washington D. C. 20037  
Tel.: 202 663 7495  
e-mail: mwebner@sughrue.com

File

**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD  
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

KAPALUA LAND CO., LTD.	)	
	)	
Petitioner,	)	
	)	
v.	)	Cancellation No. 92/040,092
	)	
KAPALUA STRICKENWAREN GmbH	)	
	)	
Respondent.	)	

**RESPONDENT'S RESPONSE TO PETITIONER'S  
FIRST SET OF ADMISSIONS TO RESPONDENT**

Pursuant to Rule 36 of the Federal Rules of Civil Procedure, Respondent Kapalua Strickwaren GmbH responds to Petitioner Kapalua Land Co., Ltd.'s First Set of Admissions to Respondent as follows:

1. Admit that Respondent was aware of Petitioner's KAPALUA mark when it filed U.S. trademark application Serial Nos. 74/657,998 and 75/038,334.

**RESPONSE:**

Denied.

2. Admit that Respondent was aware of Petitioner's KAPALUA trade name when it filed U.S. trademark application Serial Nos. 74/657,998 and 75/038,334.

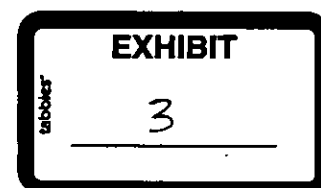
**RESPONSE:**

Denied.

3. Admit that Respondent has never sold or offered for sale dresses under the mark KAPALUA in the United States.

**RESPONSE:**

Denied.



4. Admit that Respondent has never sold or offered for sale jackets under the mark KAPALUA in the United States.

**RESPONSE:**

Denied.

5. Admit that Respondent has never sold or offered for sale suits under the mark KAPALUA in the United States.

**RESPONSE:**

Denied.

6. Admit that Respondent has never sold or offered for sale sweaters under the mark KAPALUA in the United States.

**RESPONSE:**

Denied.

7. Admit that Respondent has never sold or offered for sale pants under the mark KAPALUA in the United States.

**RESPONSE:**

Denied.

8. Admit that Respondent has never sold or offered for sale shorts under the mark KAPALUA in the United States.

**RESPONSE:**

Denied.

9. Admit that Respondent has never sold or offered for sale shirts under the mark KAPALUA in the United States.

**RESPONSE:**

Denied.



10. Admit that Respondent has never sold or offered for sale socks under the mark KAPALUA in the United States.

**RESPONSE:**

Admitted.

11. Admit that Respondent has never sold or offered for sale underwear under the mark KAPALUA in the United States.

**RESPONSE:**

Admitted.

12. Admit that Respondent has never sold or offered for sale shoes under the mark KAPALUA in the United States.

**RESPONSE:**

Admitted.

13. Admit that Respondent has never sold or offered for sale gloves under the mark KAPALUA in the United States.

**RESPONSE:**

Denied.

14. Admit that Respondent has never sold or offered for sale hats under the mark KAPALUA in the United States.

**RESPONSE:**

Denied.

15. Admit that Respondent has never sold or offered for sale laundry bleach under the mark KAPALUA in the United States.

**RESPONSE:**

Admitted.

16. Admit that Respondent has never sold or offered for sale laundry detergent under the mark KAPALUA in the United States.

**RESPONSE:**

Admitted.

17. Admit that Respondent has never sold or offered for sale perfumes under the mark KAPALUA in the United States.

**RESPONSE:**

Admitted.

18. Admit that Respondent has never sold or offered for sale essentially oils for personal use under the mark KAPALUA in the United States.

**RESPONSE:**

Admitted.

19. Admit that Respondent has never sold or offered for sale lipstick under the mark KAPALUA in the United States.

**RESPONSE:**

Admitted.

20. Admit that Respondent has never sold or offered for sale rouge under the mark KAPALUA in the United States.

**RESPONSE:**

Admitted.

21. Admit that Respondent has never sold or offered for sale eyeliner under the mark KAPALUA in the United States.

**RESPONSE:**

Admitted.

22. Admit that Respondent has never sold or offered for sale hair lotion under the mark KAPALUA in the United States.

**RESPONSE:**

Admitted.

23. Admit that Respondent has never sold or offered for sale dentifrice under the mark KAPALUA in the United States.

**RESPONSE:**

Admitted.

24. Admit that Respondent has not used the KAPALUA mark continuously from the date of registration to the present on the goods listed in Registration No. 2,016,976.

**RESPONSE:**

Admitted.

25. Admit that Respondent has not used the KAPALUA mark continuously from the date of registration to the present on the goods listed in Registration No. 2,115,124.

**RESPONSE:**

Admitted.

26. Admit that Respondent did not use the mark KAPALUA on all the goods listed in Registration No. 2,115,124 when Respondent filed its Section 8 Declaration on May 19, 2004.

**RESPONSE:**

Respondent admits that the mark was not used for socks, underwear and shoes. The mark was used for dresses, skirts, jackets, suits, pullovers, sweaters, pants, shorts, shirts, T-shirts, gloves and hats.

27. Admit that Respondent has documents in its possession which refer to Petitioner.

**RESPONSE:**

Respondent's attorney has documents in its possession which refer to Petitioner which Respondent's attorney received from Petitioner's attorney after this dispute began.

28. Admit that Registration No. 2,115,124 was assigned by Interfashion Ltd. BVI to Chris Tan Vermoengensverwaltungsgesellschaft mbH on or about August 8, 2001.

**RESPONSE:**

Admitted.

29. Admit that Registration No. 2,016,976 was assigned by Interfashion Ltd. BVI to Chris Tan Vermoengensverwaltungsgesellschaft mbH on or about August 8, 2001.

**RESPONSE:**

Admitted.

30. Admit that Chris Tan Vermoengensverwaltungsgesellschaft mbH assigned Registration No. 2,115,124 to Kapalua GmbH on or about September 14, 2001.

**RESPONSE:**

Admitted.

31. Admit that Chris Tan Vermoengensverwaltungsgesellschaft mbH assigned Registration No. 2,016,976 to Kapalua GmbH on or about September 14, 2001.

**RESPONSE:**

Admitted.

32. Admit that Kapalua GmbH assigned Registration No. 2,115,124 to Nelly GmbH on or about October 30, 2002.

**RESPONSE:**

Admitted.

33. Admit that Kapalua GmbH assigned Registration No. 2,016,976 to Nelly GmbH on or about October 30, 2002.

**RESPONSE:**

Admitted.

34. Admit that Nelly GmbH changed its name to Kapalua GmbH Luxus in Simplicity on or about April 14, 2003.

**RESPONSE:**

Admitted.

35. Admit that Kapalua GmbH Luxus in Simplicity assigned Registration No. 2,115,124 to Style & Spirit GmbH on or about November 4, 2003.

**RESPONSE:**

Admitted.

36. Admit that Kapalua GmbH Luxus in Simplicity assigned Registration No. 2,016,976 to Style & Spirit GmbH on or about November 4, 2003.

**RESPONSE:**

Admitted.

37. Admit that Nicolaus Reusch is the CEO of Style & Spirit GmbH.

**RESPONSE:**

Admitted.

38. Admit that there has never been any use of the mark KAPALUA on shoes, gloves or socks anywhere in the world by any of the owners of the mark in the chain of title of Registration No. 2,115,124.

**RESPONSE:**

Denied.

39. Admit that there has never been any use of the mark KAPALUA on laundry bleach, laundry detergent, essential oils or dentifrice anywhere in the world by any of the owners of the mark in the chain of title of Registration No. 2,016,976.

**RESPONSE:**

Admitted.

Dated: February 23, 2006

By:



Joseph F. Schmidt, Esq.

Gretchen M. Hosty, Esq.

**MICHAEL BEST & FRIEDRICH LLP**

Two Prudential Plaza

180 North Stetson

Suite 2000

Chicago, IL 60601

(312) 661-2100

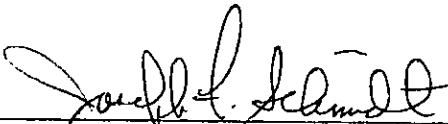
(312) 222-0818 (fax)

Attorneys for Respondent

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of **RESPONDENT'S RESPONSE TO PETITIONER'S FIRST SET OF ADMISSIONS TO RESPONDENT** was served by first class mail, postage pre-paid, on this 23<sup>rd</sup> day of February upon:


W. Mack Webner  
Leigh Ann Lindquist  
SUGHRUE, MION, PLLC  
2100 Pennsylvania Avenue, N.W.  
Washington, D.C. 20037-3202

  
\_\_\_\_\_  
One of the Attorneys for Respondent

**CERTIFICATE OF SERVICE**

I, Leigh Ann Lindquist, a partner with Sughrue Mion, PLLC hereby certify that on this 23<sup>rd</sup> day of August, 2006, a true and correct copy of the foregoing **REPLY MEMORANDUM IN SUPPORT OF PETITIONER'S MOTION FOR SUMMARY JUDGMENT** has been properly served, via First Class U.S. Mail, postage prepaid to:

Joseph F. Schmidt, Esquire  
MICHAEL BEST & FRIEDRICH LLP  
Two Prudential Plaza  
180 N. Stetson Avenue, Suite 2000  
Chicago, IL 60601

  
Leigh Ann Lindquist